



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,092	06/30/2003	Joe W. Gray	7045945002	8136

23517 7590 12/17/2010  
BINGHAM MCCUTCHEN LLP  
2020 K Street, N.W.  
Intellectual Property Department  
WASHINGTON, DC 20006

EXAMINER
----------

BRUSCA, JOHN S

ART UNIT	PAPER NUMBER
----------	--------------

1631

MAIL DATE	DELIVERY MODE
-----------	---------------

12/17/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/608,092

Applicant(s)

GRAY ET AL.

Examiner

John S. Brusca

Art Unit

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 133, 134 and 141-143.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). 12/07/2010, 5/25/201  
13. ☐ Other: \_\_\_\_\_.

/John S. Brusca/  
Primary Examiner, Art Unit 1631

Continuation of 3. NOTE: The amendment does not correct the relationship between the instant application and Application No. 09/765,291, and does not correct the relationship between Application No. 09/765,291 and Application No. 08/487,794, for which priority is claimed under 35 U.S.C. 120. If entered other deficient aspects of the claim for priority noted in the Office action mailed 25 August 2010 would be perfected. .

Continuation of 11. does NOT place the application in condition for allowance because: the amendment has not been entered.

If entered, the proposed amendment would overcome the rejections under 35 U.S.C. 112, first paragraph for lack of written description and 35 U.S.C. 112 second paragraph for indefiniteness.

If entered, the proposed amendment would overcome the objection to the Rule 63 Declaration noted in the Office action mailed 25 August 2010.

The objection to the specification for mentioning color drawings was not addressed by the applicants in their response.

The Information Disclosure Statement received 07 December 2010 is improper because an Information Disclosure Statement received after a final action requires both a fee and a certification under 37 CFR 1.97(e). The certification was not present. The illegible references provided to supplement the Information Disclosure Statement received 25 May 2010 have been reviewed and are indicated as reviewed in the attached copy of the second page of the list of references from the Information Disclosure Statement received 25 May 2010.

The rejection of claims under 35 U.S.C. 103(a) over Dryja et al. in the Office action mailed 25 August 2010 is maintained. The applicants state that Dryja et al. does not show the composition or kit comprising two probes as claimed, however Dryja et al. shows a method of using two probes that hybridize to regions flanking a deletion region (pH2-42 and 7D2) and one probe that hybridizes to a deletion region (H3-8). The claimed compositions and kits would be obvious because they would be needed to practice the process of Dryja et al. as noted in the Office action. .